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Paper No. 4

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OFFICE OF PETITIONS

In re Application of
Albert et al.
Application No. 09/896,546
Deposited: June 29, 2001
Attorney Docket No. INK-022CN2

DECISION ON PETITION

This is a decision on the "PETITION TO REVIEW A NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION UNDER 37 C.F.R. 1.53(e)(2)," filed September 6, 2001, requesting that the above-identified application be accorded a filing date of June 29, 2001 by virtue of an incorporation by reference of the omitted drawings. This petition was recently forwarded to the undersigned for consideration.

Application papers in the above-identified application were deposited on June 29, 2001. However, on August 1, 2001, the Office of Initial Patent Examination mailed a "Notice of Incomplete Nonprovisional Application," notifying applicants that the application papers had not been accorded a filing date because the application was deposited without drawings.

In reply, the instant petition was timely filed. Petitioner submits that, even if submitted without drawings, the instant application, as filed, should be accorded the filing date of June 29, 2001, and a priority date of July 20, 1995. Petitioner submitted a true copy of the application transmittal, containing an incorporation-by-reference of application No. 09/140,988. Petitioner states that the '988 includes drawings corresponding to the 13 sheets of informal drawings that were intended to be included in the package sent on June 29, 2001.

MPEP 201.06 provides in, pertinent part, that:

Material needed to accord an application a filing date may not be incorporated by reference. Therefore, if a continuation or divisional application as originally filed incorporates by reference material omitted from the application papers, which is needed to accord the application a filing date, the application will not be entitled to a filing date. A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the

incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

The application as filed included a proper incorporation by reference statement. The instant petition is being treated as the petition under § 1.182 (and required petition fee). However, the petition does not include an amendment requesting that the drawings from the prior application be included in the continuation application based on the incorporation by reference statement. More importantly, the petition does not include the 13 sheets of informal drawings.

In view thereof, the petition under § 1.182 is DISMISSED without prejudice to reconsideration upon the submission of the amendment submitting the omitted material and the omitted material, 13 sheets of informal drawings. These papers should be submitted under cover of a paper entitled "Renewed Petition under § 1.182." Petitioner is reminded that drawings needed for a filing date may not be submitted by facsimile transmission¹.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
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Telephone inquiries specific to this matter should be directed to the undersigned at (703) 305-0309.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

¹ To facilitate the quick resolution of this matter, attorney for applicants may wish to advise the undersigned by telephone when the drawings have been filed, so that she can anticipate their arrival.